

REMARKS

Claims 1-124, all the pending claims, are subject to a restriction requirement. Claim 32 has been canceled without prejudice. Claim 92 has been amended. No new matter has been added.

Claim 92 has been amended to specify a degree of homology. Support for this amendment can be found, *inter alia*, on page 14 of the application as originally filed.

The Examiner required Applicant to elect one of 754 patentably distinct inventions for examination. The Office Action alleges that each of the inventions is distinct because, *inter alia*, they are “chemical compounds each of which can be made and used without any of the other compounds.” (Office Action at page 6).

Applicant provisionally elects herein Group CXXIV, corresponding to SEQ ID NO:67, encompassing claims 30-35 and 90-92, “drawn to an isolated polypeptide comprising any one of the fifty eight different amino acid sequences recited therein, classified in class 530, subclass 350”.

Notwithstanding the foregoing, Applicant respectfully submits that no serious burden would be imposed upon the Examiner by combining several of the groups. Applicant respectfully asserts that the Markush groups identified by the Examiner should be the subject of an election of species requirement rather than requiring Applicant to file a divisional application for each sequence set forth in the Markush claims. The use of an election of species requirement would further the expressed desire for prosecution efficiency in the Patent Office.

Applicant reserve the right to prosecute the claims encompassed by any of the non-elected groups in future divisional applications.

Objections

Claims 1-39, 41, 49, 53-59, 66-73, and 78-81 were objected to as “reciting an improper Markush group. Claims 30-39, 44, 47, 52, 67, and 68 were objected to under 37 CFR 1.75(c) for failing to further limit the subject matter of a previous claim. The

Office also alleges that claims 44, 47, 52, 67, and 68 are “not product-by process claims because the processes referred to therein are analytical, not synthetic.”

Preliminarily, Applicant notes that objected claims 1-29, 36-39, 41, 44, 47, 49, 52-59, 66-73, and 78-81 do not fall in the group elected by Applicant and, therefore, are withdrawn from consideration.

Applicant disagrees with the Office’s contention that claims 30-35 fail to limit the subject matter of a previous claim. The scope of each of claims 30-35 differs from the scope of each respective previous claim. Claim 30 is broader in scope than claim 31. The scopes of claims 33 and 34 also differ from the scopes of preceding claims.

With respect to the assertion that claims 30-35 represent “an improper Markush group”, Applicant respectfully disagrees. The elected claims containing Markush groups are analogous to the example set forth in MPEP §803.02. In the example, a compound C-R is set forth with R selected from the group consisting of A, B, C, D, and E. There is no distinction in Markush claim structure between the exemplary Markush claim and the Markush-type claims of the present invention. The present objection would render the example set forth MPEP §803.02 “improper.”

The Markush groups to which the Examiner refers include groups of nucleotide sequences and groups of amino acid sequences. Each nucleotide sequence and each amino acid sequence is structurally related in as much as each sequence encodes or provides the sequence for novel G protein-coupled receptors. Each member of the groups is equally useful in the several utilities set forth in the application as filed, including, but not limited to, isolated nucleic acid molecules and polypeptides, antibodies, methods of inducing immune responses, ligand binding assays, receptor binding partners, diagnostic methods of genetic analysis, and methods of purifying G protein-coupled receptors.

Indeed, as set forth in MPEP §803.02, the Examiner is advised in situations where a Markush-type generic claim includes independent and distinct inventions, “to require a provisional election of a single species prior to examination on the merits.”

Applicant respectfully requests the reconsideration and withdrawal of the objection to the claims.

Change of Correspondence Address

As set forth on the attached "Change of Correspondence Address" form SB-122, Applicant respectfully requests that all future correspondence related to this application be directed to:

Gwilym J. O. Attwell
COZEN O'CONNOR, P.C.
1900 Market Street
Philadelphia, PA 19103-3508
Telephone: (215) 665-2000
Facsimile: (215) 701-2004

Attached hereto is a marked-up version of the changes made to the specification and claims by the current amendment. The attached page is captioned "**Version with markings to show changes made.**"

The examination of these claims and passage to allowance are respectfully requested. An early Notice of Allowance is therefore earnestly solicited. Applicant invites the Examiner to contact the undersigned at (215) 665-6904 to clarify any unresolved issues raised by this response.

Respectfully submitted,



Gwilym John Owen Attwell
Registration No. 45,449

Date: 10/10/03
COZEN O'CONNOR, P.C.
1900 Market Street
Philadelphia, PA 19103-3508
Telephone: (215) 665-2000
Facsimile: (215) 701-2004

Version with markings to show changes made

In the Claims:

Please cancel claim 32 without prejudice.

Please amend claim 92 as follows:

Claim 92 **(Amended)** The polypeptide of claim 90 wherein said polypeptide comprises an amino acid sequence [homologous] with at least 95% sequence identity to a sequence of SEQ ID NO:67.